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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,297	08/06/2003	Antonio V. Alcazar	8403.958	8018

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EXAMINER
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PALO, FRANCIS T

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/635,297

Applicant(s)

ALCAZAR ET AL.

Examiner

Francis T. Palo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,6-35,37-40,46,52-54,56-86,88-91 and 96-103 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,36,41-45,47-51,55,87 and 92-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/12/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the species in the reply filed on 8/10/04 is acknowledged; the Applicant however failed to include a listing of all claims readable thereon.

Telephone calls to the Applicant's Representatives on 10/5/04 and 11/16-18/04 did result in a listing of claims 1, 4-7, 9, 36, 41, 42, 44-51, 87, 92, 93 and 95 readable thereon the election of species.

The Examiner has reviewed the claim listings and adds claims 43, 55 and 94 to the listing as these claims are parent claims to claim groupings 44-50 and claims 87 and 95 listed by the Applicant.

Also, the examiner has determined that listed claims 6, 7, 9, and 46 are directed to non-elected species and are therefore withdrawn by the Examiner.

Resultantly, claims 1, 4, 5, 36, 41-45, 47-51, 55, 87 and 92-95 remain as readable on the elected species.

Furthermore, due to the lack of antecedent basis and lack of drawings showing claimed subject matter as discussed below, claims 43-45, 47-50 and 94-95 are not examined on their merits, leaving claims 1, 4, 5, 36, 41, 42, 51, 55, 87 and 92-93 as examinable on the merits.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, the **open area** cited in **claims 4 and 55**, the **printed pattern** cited in **claim-5**, the **extension of the sleeve portion** as cited in **claim-45**, the **detachable sleeves** of **claims 47 and 49** and the **detaching means** cited in **claim-50**, and the **skirt and sleeve portion** as cited in **claim-49**, and the **skirt extension and connection** as cited in **claims 41, 42, 92 and 93** must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures.

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The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

Appropriate correction is required.

Paragraph [0001] should be updated to reflect the patented status of 10/247,257 and 09/969,053.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

Claims 43-50 and 94-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; consequently the aforementioned claims have not been examined on the merits (see discussion below).

Regarding claims 43 and 94:

The parent claims cite a sleeve portion extending above at least a portion of the base portion; it is unclear to the Examiner if the "sleeve" portion is a rewording of the skirt portion cited in claims 36,41,42,87,92 and 93 or an additional distinct feature of the pot cover, as there is no mention of a sleeve portion in the specification.

Regarding claims 44, 45, 47-50 and 95:

The claims cite; a sleeve portion having an open upper end, a sleeve portion extending about a portion of the floral grouping, a sleeve portion connected to and detachable from a skirt portion and means for detaching the sleeve from the skirt. As discussed above, there is no antecedent basis for a sleeve portion in the specification or the drawings and there is no discussion of a sleeve connected to and detachable from a skirt portion.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,5, 36, 41, 42, 51, 87, 92 and 93** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder (US 5,120,382) 1992 in view of Goertz (EP 412317A1) 1990.

Regarding independent **claims 1 and 51**:

Weder '382 depicts in Figure-7 a flower pot cover in combination with a retaining medium, as cited in the preamble of the instant independent claims.

Weder '382 teaches thermoforming and "thermal setting" material (column-3, lines 56-67), and decorative ornamentation (column-3, lines 52-55) as cited in the instant claims, a base portion having a sidewall as defined in the instant claims is evident from the figure.

The sidewall of Weder '382 is not depicted to be devoid of overlapping folds as cited in the instant claims.

Goertz teaches a decorated plastic flower pot cover in the shape of a bucket;

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Goertz is relied upon for a pot cover devoid of overlapping folds, as cited in the independent claims.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the cover of Weder as taught by Goertz, as in the absence of any stated problems solved by or any stated advantage obtained by having a fold-free surface as claimed in the instant invention, further such modification is merely an alternate equivalent cover means performing the same intended function of containing a medium.

Regarding **claim-5**:

As mentioned above, Weder '382 teaches decorative ornamentation (column-3, lines 52-55).

Regarding repeating **claims 36 and 87**:

Weder '382 depicts in Figure-7 structure readable as a skirt portion.

Regarding repeating **claim groups 41, 92 and 42, 93**:

Weder '382 depicts a skirt portion extending from and connected to the sidewall as cited in the instant claims.



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Claims **4 and 55** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weder '382 and Goertz as applied to claims 1 and 51 above, and further in view of Weder (US 5,363,592) 1994.

Regarding repeating **claims 4 and 55**:

Weder '382 is silent as to at least one open area formed in the bottom as cited.

Weder '592 teaches pot covers having a drainage hole.

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have further modified the cover of Weder '382 to feature a drainage hole as taught by Weder '592, as cited in the instant claims, for the well-known advantages of that feature, specifically, to allow excess fluid to exit the cover.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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In consideration of the unexamined instant claims resulting from the drawing objections and the 35 U.S.C. 112 rejections, no obviousness-type double patenting rejections are made in this first and non-final office action, however they are anticipated and may be made over conflicting US Patents 6,618,990 and 5,706,605 pending the response to this office action.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morley '188 teaches a container (capable of a pot cover) readable on features such as a base, sidewall, skirt portion and sleeve portion, wherein the perceived dome shaped sleeve extends or is connected to a portion of the sidewall or skirt.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 703-305-5595. The examiner can normally be reached on M-Tu., Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 703-305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Francis T. Palo*  
Francis T. Palo  
Examiner  
Art Unit 3644